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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,968	09/10/1999	PHILLIP LEE SCANLAN	2001.2.4	5208
21552	7590	05/04/2005	EXAMINER	
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			SPOONER, LAMONT M	
			ART UNIT	PAPER NUMBER
			2654	
DATE MAILED: 05/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/394,968

Applicant(s)

SCANLAN, PHILLIP LEE

Examiner

Lamont M Spooner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18-23 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-16, 18, 21-23 and 32 is/are allowed.
- 6) ☒ Claim(s) 1-12, 19, 20, 29-31, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/10/99 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Objection- Title*

1. The title is non-descriptive as it pertains to the invention. The Examiner suggests "Machine Translation, Human Translation and Cost Quotation Processing System".

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1, and 19** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 1, page 2, "determining if a translation of the communication to a second language is required by the recipient;" "automatically determining if a quotation for human translation of the communication to the second language is required by the recipient;" and "automatically forwarding the communication, the machine translation and, the quotation to the recipient;" lacks teaching if the determinations are negative, still automatically forwarding a machine translation and quotation to the recipient, in the disclosure.

4. Claim 19 is similar to claim 1, and is thus rejected for the same reasons.

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Claims 2-12, 20, 30, and 31 depend their rejected parent claim and are thus rejected.

5. Claims 29, 33 and 34 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In **claim 29**, page 6, lines 3-11, the Applicant recites the limitations,

“receiving a communication from a sender in a first language;

automatically identifying the communication as a foreign language communication;

substantially simultaneously applying a quotation program to the communication to generate a quotation for human translation of the communication to a native language;

substantially simultaneously applying a translation program to the communication to generate a machine language translation of the communication to the native language;”.

The Applicant fails to disclose, substantially simultaneously, to either receiving a communication from a sender in a first language and/or identifying the communication as a foreign language communication, applying a quotation program to the communication to generate a quotation for human translation of the communication to a

native language. The Applicant teaches receiving the communication, and then, the following steps occur, which isn't deemed substantially simultaneous.

**Claims 33 and 34**, depend from the rejected parent claim 29, and are thus rejected.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, page 6, lines 3-11, the Applicant states,

“receiving a communication from a sender in a first language;  
automatically identifying the communication as a foreign language  
communication;

substantially simultaneously applying a quotation program to the communication  
to generate a quotation for human translation of the communication to a native  
language;

substantially simultaneously applying a translation program to the communication  
to generate a machine language translation of the communication to the native  
language;”.

The, “substantially simultaneous” steps are not clearly drawn to a particular step.  
For example,

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substantially simultaneously (to the previous substantially simultaneous step, automatically identifying step, or the receiving step) applying a quotation program to the communication to generate a quotation for human translation of the communication to a native language, thus rendering the claim unclear, vague and indefinite.

**Claims 33 and 34**, depend from the rejected parent claim 29, and are thus rejected.

***Allowable Subject Matter***

8. Claim 13-16, 18, 21-23, and 32 are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter:

The instant application is deemed to be directed to a non-obvious improvement over the invention patented in Church (5,608,622) in view of Globalink. The improvement comprising forwarding the communication, the machine translation and the quotation for a human translation of a foreign language communication to a native language, simultaneously.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lamont M Spooner whose telephone number is 571/272-7613. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on 571/272-7602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lms  
4/26/05

  
**RICHEMOND DORVIL**  
**SUPERVISORY PATENT EXAMINER**